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In re Application of :  
DuToit et al. :  
Application No.: 09/979,586 :  
PCT No.: PCT/IB00/00739 :  
Int. Filing Date: 22 May 2000 : DECISION  
Priority Date: 20 May 1999 :  
Attorney Docket No.: 8436.88USWO :  
For: Variable Phase Shifter :

This is a decision on the papers filed on 07 June 2002, which are being treated under 37 CFR 1.497(d).

### **BACKGROUND**

This international application was filed on 22 May 2000 and claimed a priority date of 20 May 1999. The International Bureau transmitted a copy of the published international application to the USPTO on 11 January 2001. A Demand electing the United States was filed prior to the elapse of 19 months from the priority date. Consequently, the thirty period for payment of the basic national fee in the United States expired as of midnight on 20 November 2001. On 20 November 2001, applicants filed *inter alia* the basic national fee.

On 16 January 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e).

On 14 March 2002, applicants filed a response, including a declaration and a surcharge under 37 CFR 1.492(e).

On 05 April 2002, a Notification Of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, requiring the requiring the submission of an executed oath or declaration and indicating that "There is an inventor added to the declaration that is not identified on any documents associated with this Application."

On 08 May 2002, applicants filed a declaration.

On 07 June 2002, applicants filed papers under 37 CFR 1.497(d).

On 08 October 2002, a Decision regarding the papers under 37 CFR 1.497(d) was mailed to applicants, indicating that the papers would not be considered. The decision indicated that according to 35 U.S.C. 367 the application had become abandoned with respect to the United States because the international application was withdrawn before applicants had

complied with the requirements of 35 U.S.C. 371(c).

Applicants filed the instant response on 12 November 2002.

### DISCUSSION

The instant response is accompanied by a copy of a Communication In Cases For Which No Other Form Is Applicable (Form PCT/IB/345) indicating that the international application had been erroneously indicated to have been withdrawn, and that the Notification of Withdrawal (Form PCT/IB/307) should be disregarded. In view of this evidence, the holding of abandonment was in error and is hereby VACATED.

It is now appropriate to consider the papers under 37 CFR 1.497(d), which seek to add as an inventor an individual, John Heywood Thomson, who is not listed in the published international application.

A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.). The papers satisfy requirements (1) and (2).

Regarding requirement (1), applicants have provided a statement from John Heywood Thomson that the error in inventorship occurred without deceptive intention on his part.

Regarding requirement (2), applicants have paid the \$130.00 surcharge under 37 CFR 1.492(e) twice: first on 14 March 2002 and again on 08 May 2002. The second payment of the surcharge is being applied to the required processing fee under 37 CFR 1.497(d)..

Regarding requirement (3), the instant papers includes a "Certificate Under 37 C.F.R. § 3.73(b)" consenting to the addition of John Heywood Thomson as an inventor. The "Certificate..." is signed by James F. Petelle as "Vice President and Secretary," and indicates that Mr. Petelle "is empowered to act on behalf of the assignee." The "Certificate..." is accompanied by copies of an assignment document signed by all four of the inventors named on the declaration filed on 08 May 2002. These papers satisfy the requirements of 37 CFR 1.497(d)(3) and 3.73(b).

The signed declarations filed on 08 May 2002 fail to satisfy 37 CFR 1.497 because applicants have not filed complete copies of each of the declarations as signed by the inventors. Instead, the declaration appears to have been assembled from selected parts of the declarations as signed. Applicants are required to provide complete copies of the declarations as signed. Also, the declaration is deficient in that the first name of the first listed inventor ("Cornelis" or "Cornelia") differs from that appearing on the face of the published

international application ("Cornelius").

For the reasons explained above, it would not be appropriate to accept the papers under 37 CFR 1.497(d) on the basis of the present record.

**CONCLUSION**

The request to withdraw the holding of abandonment is **GRANTED**.

The papers filed under 37 CFR 1.497 (d) are not accepted.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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